

REMARKS/ARGUMENTS

Entry of these Remarks and reconsideration of all claims remaining of record is earnestly requested. Claims 11-14, 17-22 and 25-33 are currently pending.

The rejection of claims 11, 13, 14, 17-22, 25-27 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garrido (USP 5,451,053) in view of Ho (USP 5,259,626), Marcus et al. (USP 5,643,087) and Ishiwata et al. (USP 4,870,389) is respectfully traversed.

Contrary to the PTO's assertions in the 1/25/05 Official Action that the teachings of Ho ('626) indicate that Garrido ('053) supports two-way communication between the joystick controller and the game console, Applicants respectfully contend that Garrido ('053) does not provide support for such two-way communication even in view of Ho ('626). Regardless of the disclosure in the Ho ('626) reference, there is clearly no teaching or suggestion in Garrido ('053) of two-way communication between the controller and the console.

In addition, Applicants respectfully contend that Ho ('626) does not teach or suggest the specific communication features set forth in at least independent claims 11 and 19. As is pointed out in the 1/25/05 Official Action, Ho ('626) discloses a communication line having a bi-directional arrow (see item 102a in Fig. 2). However, there is no further disclosure or discussion by Ho regarding this communication line and there is no teaching of what this communication line is used for in the system described by Ho. More particularly, Ho does not disclose "processing circuitry for responding to a command from said game program executing processing system to transmit said joystick data to said game program executing processing system", as expressly set forth in independent claim 11. Moreover, neither Marcus ('087) nor Ishiwata ('389) appear to make up for the deficiencies of Garrido and Ho.

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F. 2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Thus, Applicants respectfully contend that the above rejection is not supported by the actual teachings of the references cited.

Applicants also contend that the rejection of independent claim 19 is not supported by the cited references. Claim 19 requires that the portable storage device include video game instructions which cause the game program executing processing system to send a command to the controller to transmit the joystick data. Clearly, the depiction of communication line 102a alone in Ho does not teach or suggest this feature. Accordingly, Applicants contend that the rejection of independent claim 19 is improper at least for substantially the same reasons as discussed above with respect to the rejection of claim 11.

The rejection of claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Garrido ('053) in view of Ho ('626), Marcus et al. ('087), Ishiwata et al. ('389) and Reed et al. (USP 5,577,735) is respectfully traversed.

With respect to independent claim 27, Garrido also fails to disclose the claimed feature of having instructions in the portable storage device for displaying a plurality of player controlled objects each having distinctive associated motion characteristics, and instructions for responding to changes in the joystick position to control the selection of one of the plurality of player controlled objects. While Garrido does provide a reconfigurable video game controller, it does not enable the selection of a player controlled object in the manner defined in claim 27. In addition, Garrido fails to provide a display displaying a plurality of player controlled objects each having a distinctive associated motion characteristic (see e.g., Fig. 29 of Applicant's specification), or instructions for enabling the joystick to be used to select one of the player

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controlled objects for use in the game, as defined in independent claim 27. Moreover, neither Ho ('626), Marcus et al. ('087), Ishiwata et al. ('389) and Reed et al. (USP 5,577,735), considered either alone or together with Garrido, teach or suggest providing instructions for responding to changes in a joystick angular position to control the selection of one of the plurality of player controlled objects having distinctive associated motion characteristics, as set forth in claim 27.

In view of Applicants' foregoing remarks, it is believed that the application is in condition for allowance. Favorable consideration and allowance of this application are respectfully solicited. If any small manner remains outstanding, the Examiner is encouraged to telephone Applicants' representative at the telephone number listed below or on the following page.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



William G. Niessen

Reg. No. 29,683

*For Joseph S. Presta
Reg. No. 35,329*

WGN:ap
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100